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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,067	03/10/2004	Thomas M. Demartini	111325-370200	2653
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EXAMINER				
KAMAL, SHAHID				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/796,067

**Applicant(s)**

DEMARTINI ET AL.

**Examiner**

SHAHID KAMAL

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 12/13/2004, 02/19/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of Claims*

1. This Office Action is response to the application filed on March 10, 2004.
2. The claims 1-33 are currently pending and have been examined

### *CIP*

3. This application is a continuation-in-part ("CIP") application of U.S. application no. 10/388,161 filed on March 14, 2003, which claims benefit of 60/363,932 filed on March 14, 2002. See MPEP §201.08. In accordance with MPEP §609.02 A. 2 and MPEP §2001.06(b) (last paragraph), the Examiner has reviewed and considered the prior art cited in the Parent Application. Also in accordance with MPEP §2001.06(b) (last paragraph), all documents cited or considered 'of record' in the Parent Application are now considered cited or 'of record' in this application. Additionally, Applicant(s) are reminded that a listing of the information cited or 'of record' in the Parent Application need not be resubmitted in this application unless Applicants desire the information to be printed on a patent issuing from this application. See MPEP §609.02 A. 2.

### *Information Disclosure Statement*

4. The Information Disclosure Statement filed on 04 February 2003 and 18 February 2004 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-12 and 25-27 are rejected under 35 U.S.C. 102(e) as anticipated by Gilliam et al. (US Patent No. 7,206,765 B2).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Referring to claim 1, Gilliam discloses: a) specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a variable and corresponding value for said variable [see at least column 7, lines 11-23, column 8, lines 1-9, column 23, lines 34-47, column 26, lines 2-15 (the file and at least one response with private keying material that it can access)];

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b) generating a profile of said rights expression information, including removing said value for said variable from said element [see at least column 9, lines 6-22 (col. 11, lines 6-11 – the rights can be in the form of a profile; col. 7, lines 39-55 – each time the usage rights is exercised, the value of the state variable can be incremented, which is interpreted as removing the value); and

c) generating an identification for said profile [see fig. 1 & fig. 3 with associated text],

d) whereby said rights expression information can be enforced on a device based on said variable and said identification for said profile [see abstract & claim 1].

Referring to claim 2, Gilliam further discloses transmitting said identification for said profile to a device adapted to situationally determine said variable and enforce said rights expression information based on said variable and said identification for said profile [see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights].

Referring to claim 3, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said profile in a predetermined order and situationally determining untransmitted variables [see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights ].

Referring to claim 4, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said profile in a non-predetermined order and situationally determining untransmitted variables [see at least column 9,

lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights ].

Referring to claim 5, Gilliam further discloses transmitting said identification for said profile along with machine-interpretable reconstruction instructions to a device adapted to follow said machine-interpretable reconstruction instructions to determine said variable and enforce said rights expression information based on said variable and said identification for said profile see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights ].

Referring to claim 6, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said profile in a predetermined order and determining untransmitted variables according to said machine-interpretable reconstruction instructions [see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights ].

Referring to claim 7, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said profile in a non-predetermined order and determining the untransmitted variables according to said machine-interpretable reconstruction instructions [see at least column 9, lines 16-45 – the user makes a request from the vendor is receives the ticket item, which includes rights ].

Referring to claim 8, Gilliam further discloses transmitting said identification for said profile to a device adapted to follow machine-interpretable reconstruction instructions to determine said

variable and enforce said rights expression information based on said variable and said identification for said profile [see at least column 9, lines 16-45 – the user makes a request from the vendor is receives the ticket item, which includes rights ].

Referring to claim 9, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said profile in a predetermined order, determining the machine-interpretable reconstruction instructions associated with said profile, and determining untransmitted variables according to said machine-interpretable reconstruction instructions [see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights ].

Referring to claim 10, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said profile in a non-predetermined order, determining the machine-interpretable reconstruction instructions associated with said profile, and determining the untransmitted variables according to said machine-interpretable reconstruction instructions see at least column 9, lines 16-45 – the user makes a request from the vendor is receives the ticket item, which includes rights ].

Claim 11-22 are rejected on the same rationale as claims 1-10 above.

Claims 23-33 are rejected on the same rationale as claims 1-10 above.

**7. Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific

limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

8. Although Applicant(s) use “means for” in the claim(s) (*e.g.* claims 11-33), it is the Examiner’s position that the “means for” phrase(s) do not invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances of “means for” from the claim(s), or to explicitly state on the record why 35 U.S.C. 112 6<sup>th</sup> paragraph should not be invoked.

Alternatively, if Applicant(s) desire to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. 112 6<sup>th</sup> paragraph, the “means for” phrase(s) will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6<sup>th</sup>*.<sup>1</sup>

Failure by Applicant(s) in their next response to also address the 35 U.S.C. 112 6<sup>th</sup> paragraph issues in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) NOT to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. 112 6<sup>th</sup> paragraph applies to all examined claims currently pending.



***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the patent examiner should be directed to Shahid Kamal whose telephone number is (571) 270-3272. The Patent examiner can normally be reached on Monday-Thursday (9:00am -7:00pm), Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for this origination where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-directed.uspto.gov>.

Should you have any questions on accessing to the Private PAIR system, contact the Electronic Business Center (EBC) at 1(866) 217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 1(800) 786-9199 (IN USA OR CANADA) or 1(571) 272-1000.

Shahid Kamal  
March 11, 2008

/Jalatee Worjloh/

Primary Examiner, Art Unit 3621